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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,054	09/15/1999	YOSHIHITO ISHIBASHI	09812.0583-00000	6914
22852	7590	04/29/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER ABEL JALIL, NEVEEN	
			ART UNIT	PAPER NUMBER
			2165	
			MAIL DATE	DELIVERY MODE
			04/29/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/396,054

**Applicant(s)**

ISHIBASHI, YOSHIHITO

**Examiner**

Neveen Abel-Jalil

**Art Unit**

2165

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2007 and 20 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 14-16, 18, 20-25, 29-34 and 38-41 is/are rejected.
- 7) ☒ Claim(s) 6-13, 17, 19, 26-28 and 35-37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 3/11/08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the Appeal Brief filed on December 3, 2007 and April 20, 2008, PROSECUTION IS HEREBY REOPENED. *A new ground of rejection is set forth below.*

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Claims 1-41 are now pending.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-5, 14-16, 18, 20-25, 29-34, and 38-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al. (U.S. Patent No. 6,226,618).

As to claims 1, and 20, Downs et al. discloses a content management method for managing content data provided to user equipment, comprising the steps of:

storing a content key encrypted with a first storage key, content data encrypted with the content key, and a second storage key in the user equipment (See Figure, and see column 11, lines 38-54);

sending the encrypted content key (see column 23, lines 29-33, wherein the sending is being preformed by content providers) and the second storage key to a key management unit (See column 22, lines 32-38, wherein "Key management unit" is read on "Clearing house");

at the key management unit, decrypting the encrypted content key using the first storage key, the first storage key being stored in the key management unit (See column 24, lines 34-40);  
and

encrypting the decrypted content key using the second storage key (See column 22, lines 25-36, and column 24, lines 19-22);

sending the content key encrypted with the second storage key to the user equipment (See column 10, lines 60-65); and

at the user equipment (End user device), decrypting the encrypted content key using the second storage key and decrypting the content data using the decrypted content key (See column 24, lines 47-55).

As to claims 2, and 21, Downs et al. discloses wherein the second storage key is generated based on random number (See column 15, lines 64-67, wherein it is inherent for security that keys are generated using random numbers).

As to claims 3, and 22, Downs et al. discloses wherein the decrypted content key is encrypted with identification information of the user equipment and stored in the user equipment (See column 23, lines 21-28, wherein Application running on user equipment is assigned an ID).

As to claims 4, and 23, Downs et al. discloses wherein the content key is encrypted, in the user equipment, with the first storage key and identification information of the user equipment, and the content key stored in the user equipment is decrypted with the first storage key and the identification information of the user equipment (See column 24, lines 48-57).

As to claim 5, Downs et al. discloses wherein the second storage key is generated by a decrypted key generating means provided in the user equipment (See column 15, lines 1-5, wherein it is inherent if its taught that end user digital certificate is used to sign content then it must be generated at the end user equipment).

As to claims 14, 29, and 38, Downs et al. discloses wherein the user equipment has stored therein identification information of the user equipment (See column 23, lines 21-28, wherein Application running on user equipment is assigned an ID).

As to claims 15, and 30, Downs et al. discloses wherein the data storage starts decrypting the content key stored in the second storing means depending on the result of inspection of the identification information of the data storage, stored in the second storing means (See column 24, lines 17-47, wherein "result of inspection" reads on "verifying information").

As to claims 16 and 40, Downs et al. discloses as modified wherein the decrypted content key supplied from the user storing has added thereto information that the content key has been obtained by restoration (See column 21, lines 43-67, wherein "restoration" is renewing of license).

As to claims 18, and 41, Downs et al. discloses wherein the content key has added thereto frequency information which limits the number of times the content key can be used (See column 20, lines 42-49, wherein "limits the number of times" reads on "usage information").

As to claims 22, and 39, Downs et al. discloses wherein the encrypting means encrypts the decrypted content key with identification information of a second storing means (See column 22, lines 26-52, wherein it is inherent that keys for security will include identification information of storing means they belong to).

As to claim 23, Downs et al. discloses wherein the content key is encrypted, in the first storing means, with the first storage key and identification information of the first storing means (See corresponding rejections in relevant claims above); and

the content key stored in the first storing means is decrypted with the first storage key and the identification information of the first storing means (See corresponding rejections in relevant claims above).

As to claims 24, and 31, Downs et al. discloses wherein the first storing means, first decrypting means, and encrypting means form together a data storage, wherein the key management unit manages the second storage key of the data storage (See column 22, lines 26-52, "key management unit manages" is read on "clearing house").

As to claims 25, and 32, Downs et al. discloses wherein the data storage is a data receiver which receives a content data encrypted and sent from a data transmitter (See abstract, wherein "receiver" is read on either "clearing house" or "end user device" and "transmitter" is read on "content provider").

As to claim 33, Downs et al. discloses wherein the key management unit comprises an identification information storing means in which the identification information of the first storing means is stored (See Figure 2, wherein all keys accounted for by the clearing house (i.e. key management unit) are attached to IDs).

As to claim 34, Downs et al. discloses wherein the key management unit accounts the data service following the predetermined procedure depending upon a generation of the second storage key (See column 3, lines 46-55, wherein a second key is generated but wherein it is unclear from the claim language what the "predetermined procedure" is).

***Allowable Subject Matter***

5. Claims 6-13, 17, 19, 26-28 and 35-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. For cited art, see PTO-form 892.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian P. Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neveen Abel-Jalil  
Primary Examiner  
April 27, 2008  
/Neveen Abel-Jalil/  
Primary Examiner, Art Unit 2165